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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,416	07/27/2001	Yukio Yamori	SAEGU85.001A	1599

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EXAMINER

ZUCKER, PAUL A

ART UNIT PAPER NUMBER

1621

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/890,416

YAMORI ET AL.

Examiner

Paul A. Zucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-11 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 20-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-10, 19 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 11 and 20-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Current Status

1. This action is responsive to Applicants' amendment of 25 April 2003 in Paper No 10.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Applicant's cancellation of claims 4-6 and 12-18 is acknowledged.
4. Applicant's addition of new claims 5-15 is acknowledged.
5. Claims 1-3, 7-11 and 19-29 remain pending.
6. The objection to the specification set forth in paragraph 9 of the previous Office Action in Paper No 9 is withdrawn in response to Applicant's amendment.
7. The rejection under 35 USC § 102(b) set forth in paragraph 10 of the previous Office Action in Paper 9 is withdrawn in response to Applicant's amendment.
8. The rejection under 35 USC § 103(a) set forth in paragraph 11 of the previous Office Action in Paper No 9 is withdrawn in response to Applicant's amendment.

New Rejections

Election/Restrictions

9. Newly amended claims 11 and 20-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Previously submitted claims 11 and 20-25 were directed to "a method for preventing or treating diseases accompanied by a decrease in bone weight" while claims 11 and 20-25 as currently presented are directed to "a method for increasing breaking load and breaking energy without significantly increasing bone density".

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Newly amended claims 11 and 20-25 therefore exclude the subject matter, and art readable thereon, of the previously presented claims 11 and 20-25 since bone density is increased by increasing bone weight.

The search required for new amended claims 11 and 20-25 is therefore, by definition, not co-extensive with that required for previously presented claims 11 and 20-25. Claims 11 and 20-25 as previously and currently presented therefore define patentably distinct inventions.

Because these inventions are distinct for the reasons given above and the search required for current claims 11 and 20-25 is not required for previously presented claims 11 and 20-25 restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11 and 20-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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10. Claim 28 is finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 28 recites the limitation "hypertension or the disease resulting from hypertension" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 19, 26, 27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruf et al (Arteriosclerosis, Thrombosis and Vascular Biology, Platelet Rebound Effect of Alcohol Withdrawal and Wine Drinking in Rats. Relation to Tannins and Lipid Peroxidation, 1995, 156(1), pages 140-144). **NOTE:** For the purposes of this rejection the dictionary definition of "cerebral apoplexy" as "stroke" is employed.

Ruf discloses (Page 140, column 2, lines 7-12 (not including abstract)) that the alcohol-withdrawal rebound effect in alcoholic subjects results in an increased risk of stroke. Ruf discloses (Page 142, column 2, lines 8-19 (not including table) and column 1, bottom, Fig. 2) that wine and grape seed extract exert a protective effect against platelet aggregation (the putative cause of the rebound effect). Ruf further discloses (Page 140, column 1, lines 18-20 (not including abstract)) that wine tannins contain resveratrol (a compound of formula 1). The ethanolic solutions of tannins from grape seed extract disclosed constitute a pharmaceutical composition.

Wine, of course, is a food product derived from plants of the Vitaceae family. Claims 19, 26, 27 and 29 are therefore anticipated by Ruf.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1 and 7- 10 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hirschberg (WO 99/35917-A1 07-1999).

Instantly claimed is a composition comprising a pharmaceutically acceptable carrier and a stilbene of formula (1) wherein the composition is in the form of a food product, in particular a juice.

Hirschberg teaches (Page 1, lines 18-23) methods for infusing compositions including phytochemicals and nutraceuticals (food/pharmaceutical compositions) into food products including juices. Hirschberg teaches (*ibid*) that the resulting food products can be used to alleviate dietary insufficiency or in the prevention or treatment of disease. Hirschberg further suggests (Page 3, lines 19-24) the use of resveratrol (a stilbene of instant formula (1)) along with vitamins in the infusion solutions. Hirschberg specifically teaches (Page 10, line 22 – page 11, line 2) the use of vitamins A, B, C, D, E and K in the infusion solutions as well.

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The difference between the compositions taught by Hirschberg and the compositions instantly claimed is that Hirschberg does not exemplify the use of resveratrol in juice compositions.

Hirschberg, however, provides a clear suggestion to use resveratrol in the juice compositions that he teaches. One of ordinary skill in the art would have been motivated by this suggestion to make the instant invention. There would have been a reasonable expectation of success since Hirschberg teaches the suitability of resveratrol for this purpose. The instantly claimed compositions would therefore have been obvious to one of ordinary skill in the art.

Conclusion

13. Claims 1-3, 7-11 and 19-29 remain pending. Claims 1-3, 7-10, 19 and 26- 29 are finally rejected. Claims 11 and 20-25 are held finally withdrawn from consideration as being directed to a non-elected invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 703-306-0512. The examiner can normally be reached on Monday-Friday 7:00-3:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Paul A. Zucker
Patent Examiner
Technology Center 1600

July 11, 2003



Johann Richter, Ph.D., Esq.
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Technology Center 1600